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Dispute Settlement of Domain Names under Uniform Disputes Resolution Policy (UDRP)

Introduction

In the commercial life, domain names function as telephone and fax numbers. If the manager's business card doesn't present a domain name, his company run the risk of being completely passed over by consumer that prefer to browse trader and services online. A good domain name is very important for a commercial entity. If the name does not match the trade or company name or trademark then it must be closely related to one or both. The domain name must also be easy to remember so that consumers should easily find the site online via the company's domain name. Nowadays, registering a domain name of a website is the first priority for a trade, because it is a very cheap method to get your company name and information in front of the public.¹

In other words, one of the active elements in commerce through the Internet is domain names. A domain name is simply that guides computers and users to the site that corresponds to the address through the Internet. For that reason domain names may play a significant role when a trademarked name is used as a company's domain name through the Internet, and consumers identify where to go online to conduct business with that company.

However, using domain names has generated a rapidly growing set of disputes, such as, conflicts between firms asserting traditional trademark entitlements and the registrants of identical or confusingly similar domain names (such as Cyberquatting, Typo-squatting).

In general, the dispute of domain name happens when the domain name is identical or confusingly similar to a famous trademark or service mark owned by trademark or service owner (such as, Cyberquatting, Typo-squatting).

This study will discuss the main methods by which the conflict between domain names and trademark can be settled internationally through the Uniform Dispute Resolution Policy adopted (UDRP) which adopted by the Internet Corporation for Assigned Names and Numbers (ICANN). According to the (UDRP): the trademark owner must prove that the domain name registered is identical or confusingly similar to a trade or service mark in which the trademark owner has rights, the registrant has no rights

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¹ BURNS-MILLYARD, KATHY: What is a Domain Name and Why Do You Need One?, 2013, <http://www.cyberindian.com/domain-registration/what-is-a-domain-name.php> (Accessed: 8 Jan 2015)

or legitimate interests in respect of domain name registered, and the domain name has been registered and is being used in bad faith.²

This paper discusses the dispute settlement of domain name under the Uniform Disputes Resolution Policy (UDRP) through the following frames:

1. What is the domain name?

Nowadays, the Internet represents a combination of shop window by creating a whole new marketplace. So every website includes information provided by the designer of that "website". When a commercial entity wants to market its goods or services through the Internet, it usually does so by designing a website and posting information concerning goods or services to that site. Therefore, domain names are means, which are used to introduce users of the Internet to activities and commercial services presented through the web. For example a merchant, a company, or a service provider can choose a domain name and register it at the competent authorities offering through it the goods or services he provides, through the Internet.³ In the traditional sense, one shall visit the place of business of the company in order to buy goods or obtain services, which carries a trading name. In the Internet world, the domain name will be more than sufficient to provide for such need. Moreover, most companies with valuable trademark will have proper use handbook to refer to use of their marks on the website.⁴

In other words, one of the active elements in commerce through the Internet is the domain name. It guides computers and users to the site that corresponds to the address through the Internet, for that reason domain name may play significant role when a trademarked name is used as a company's domain name through the Internet, consumers identify where to go online to conduct business with that company.

The domain name makes IP address easier by allowing a familiar string of letters the domain name to be used instead of the hidden IP address. So instead of typing 192.0.34.65, you can type the trademark nike as a domain name.⁵ As a result, the domain name makes addresses easier to remember.

2. What are the differences between domain name and trademark?

There is no doubt that domain names and trademarks are similar in nature, however, they differ in their functions. Trademarks are used to distinguish goods or services of a trader. On the other hand, domain names serve as a new method to provide an address that

² Internet Corporation for Assigned Names and Numbers (ICANN), Uniform Domain-Name Dispute-Resolution Policy, 2003, <https://www.icann.org/resources/pages/help/dndr/udrp-en> (Accessed 9 October 2015).

³ Taking into consideration that he can ask to register any domain name, provided that it has not been previously registered.

⁴ Sections of such a proper use handbook can be put on the company's web page in order to state if that trademark prepared to license others to use its marks in certain circumstances. For more information see: SMITH, GRAHAM: *Internet Law and Regulation*, Third edition, Sweet & Maxwell, London, 2002, p. 75.

⁵ Nike, select your location, 2015, www.nike.com (Accessed 8 Jan 2015)

identifies a specific location on the internet.⁶ Trademarks have to be registered in relation to certain goods and services, domain names are not linked to any goods and services but it used to identify businesses on the Internet. It remains registered as long as the domain name registration is valid and renewed while the scope of protection of a trademark is determined by those goods and services for which a trademark is registered and it can be revoked if they are not used for these goods and services for which they are registered.⁷ Further, the registration system of trademarks is administered by a governmental authority on a territorial basis (either domestic, regional or international), while the domain names registration system is usually administered by a non-governmental organization without any functional limitation.⁸

It is very important to recognize the main differences between domain names and trademarks through the following table:⁹

Trademark	Domain name
Trademark registrations are national or regional.	Domain names are visible in all countries.
Trademark registration protects use of the mark in the course of trade.	The purpose of the domain name registrant may be commercial or not.
Trademark is registered for specified types of good or services.	The registration of a domain name (in the open TLDs) is not linked to any specific class of goods or services.
The same trademarks can be registered for different goods or services by numerous different applicants.	Only one instance of a domain name can be registered.

As mentioned above, there are some interactions between trademarks and domain names, however, the following are clarifications on these differences which have been sustained most of the confusion in this area:

- Identical trademarks can be used for different classes of goods, domain names are restricted to just one. Domain names are not classified, as trade mark classes, for goods and services.¹⁰
- A trademark rights, are national by nature so the similar products with the same trade mark can be sold by different companies in different countries, while domain name have no geographical limitations.¹¹

⁶ KORMAN, Tomas, the Relationship between Domain Names and Trademarks, LL.M. Thesis, Legal Studies Department, Central European University, 2013, P1.

⁷ Ana Rac ki Marinkovic, On Domain names and Trademarks, Journal of Internet Law, 2012, P30-31

⁸ World Intellectual Property Organization (WIPO), WIPO Internet Domain Name Process, 2015, <http://www.wipo.int/amc/en/processes/process1/> (Accessed 9 Jan 2015)

⁹ SMITH 2002, p. 84.

¹⁰ Queensland Government, What are the differences between trademarks, business names, company names and domain names?, Australia, 2015, <https://www.business.qld.gov.au/business/support-tools-grants/tools/intellectual-property-info-kit/browse/names/differences> (Accessed 15 November, 2015)

¹¹ World Intellectual Property Organization, Research Papers from the Wipo-Wto Colloquium for Teachers of Intellectual Property (2010): http://www.wipo.int/export/sites/www/academy/en/courses/academic_institutions/pdf/wipo_wto_colloquium_2010.pdf (Accessed 15 October, 2015).

- Trademark rights arise from registering the mark with a governmental entity. In other words, trade mark rights are administered by governmental entities, e.g. the Trademarks Registration Office in UK is a governmental body. The Intellectual Property Office (IPO) is the official government body responsible for intellectual property rights in the United Kingdom. The IPO will receive and process trade mark applications and where an application is successful, will register the trade mark.¹² In the event of a dispute over the rights over trade mark, there are procedures to oppose registration and to settle such disputes. On the other hand, domain names are not administered by the state but are granted by private companies.¹³ These companies will naturally intend to increase commercial profit margins through selling and registering more domain names for customers all over the world.
- By registering of a specific trade mark is not enough for the purpose of possession of the rights; it must be in use to sustain the rights of registration and avoid cancellation of the trademark.¹⁴ On the other hand, mere registration of a domain name could be held endlessly with no effect for non-use, so it might be registered but without any use.

It should be mentioned here that the fact that the relation between trademark and domain name is a modern issue and there is no clear international legal system to clarify the interaction between trademarks and domain names on cyberspace.

3. *Disputes of Domain Names*

The most obvious manner in which a the dispute of domain names may arise, is when the domain name will be identical or confusingly similar to another's well-known trademark, which confuses Internet browsers and users, between the owner of visited website and trademark known by the audience to distinguish specific good or product. The commercial firms are trying to develop some new means of dealing with their trademarks by making use of the goodwill they acquired in the real word and transfer that such goodwill to the Internet by registering their famous trademark as domain name. One might register a trademark, which belongs to a well-known world firm, as a domain name and tries to extort such firm through asking it to pay large amounts of money in order to assign the registered domain name or transfer it to the firm. For example, registration domain name under www.burgerking.com. This type of conflict between domain names and trademarks is called as Domain Name Piracy or Cybersquatting.¹⁵

¹² TAYLOR, ALASDAIR: *How to register a UK trade mark without a lawyer*, 2011, <http://www.seqlegal.com/blog/how-register-uk-trade-mark-without-lawyer> (Accessed 17 October 2015).

¹³ Exception of the ccTLD domain names, these domain names are granted by governmental bodies in many countries.

¹⁴ Article 19 of Trade-Related Aspects of Intellectual Property Rights Agreement, (TRIPS agreement). World Trade Organization (WTO), Trade-Related Aspects of Intellectual Property Rights Agreement, (TRIPS agreement), 2015, https://www.wto.org/english/tratop_e/trips_e/trips_e.htm (Accessed 20 January 2015).

¹⁵ CHISSICK, MICHAEL, *Electronic Commerce: law and practice, third edition*, Sweet&Maxwell, London, 2002, p. 24.

Another type of conflict between domain names and trademarks is (*Typosquatting*). This type of dispute happens when someone uses a trick or deception in registering a domain name largely similar or close to the famous trademark owned by the firm, with a slight modification on some letters of the trademark, which he shall register as a domain name.¹⁶ For example:

- Registering a domain name www.microosoft.com, adding other (o) to the well-known trademark Microsoft.
- Registering a domain name www.wwwhotmail.com, adding another (www) to the well-known trademark hotmail.
- Registering a domain name yafoo.com, placing of the letter (f) instead of (h).

However, there are many types of disputes of domain names in the cyberspace, but the main common disputes are registering trademarks as domain names as a follow:

1. Registering a domain name completely identical with a registered trademark (Domain Name Piracy) (Cybersquatting).
2. Registering a domain name largely similar to a registered trademark (Typosquatting)
3. Registering a trademark as a domain name to express the dissatisfaction with a product or service provided by a certain corporation (Cybersmearing) (derogatory domain names).
4. The attempt to deprive a properly registered domain name holder from the domain name he registered (Reverse Domain Name Hijacking).
5. Registering a trademark that belongs to others as a domain name when the domain name holder fails to renew the registration.
6. Registering a trademark of a competitor as a domain name (competing use) or registering a trademark of non-competitor as a domain name (non-competing use).¹⁷

This paper stated the most well-known disputes, Cybersquatting and Typosquatting.

4. Dispute Settlement between Domain Names and Trademarks under the Uniform Disputes Resolution Policy (UDRP)

International dispute settlement between domain names and trademarks are the outcome of the effort of several bodies concerned with finding solutions for the conflict between domain name and trademark and as such to satisfy some of the trademark owners concerns.

One of these bodies was Internet Corporation for Assigned Names and Number (ICANN), which is responsible for the administration of the generic Top Level Domain

¹⁶ It is very important to note that this registration of domain names is not identical as in the first type mentioned above. LINDSAY DAVID: *International Domain Name Law*: ICANN and the UDRP, Bloomsbury Publishing, 2007. p. 259.

¹⁷ World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions, 2015, <http://www.wipo.int/amc/en/domains/search/> (Accessed 10 September 2015).

(gTLDs).¹⁸ The ICANN adapted in August 1999 a Uniform Disputes Resolution Policy.¹⁹ UDRP states that any person or entity with rights in a trademark may initiate an administrative dispute resolution proceeding by submitting a complaint to one of the seven ICANN approved dispute resolution service providers:

1. Asian Domain Name Dispute Resolution Center (ADNDRC);
2. The World Intellectual Property Organization (WIPO);
3. The National Arbitration Forum (NAF);
4. E-Resolution;
5. The CPR Institute for Dispute Resolution;
6. Arab Center for Domain Name Dispute Resolution (ACDR);
7. The Czech Arbitration Court Arbitration Center for Internet Disputes.²⁰

Further, each conflict between domain name and trademark filed under the UDRP will be resolved within 57 days of the date on which the provider receives the complaint.

However, the applicability of the UDRP stems from the registrant's consent. When a person is keen to register a trademark as a domain name under ICANN, that person is asked to enter into a contract incorporating the terms of the dispute policy.²¹ On the other hand, the registration of a domain name does not mean that the registrant or owner of the domain name is protected from threat of cancellation or transfer of its domain name. Such registered domain name can be identical or confusingly similar to a famous trade or service mark. Most of conflicts between domain names and trademarks in cyberspace are represented in registering identical or similar domain names with them. As a result, the owner of the famous trademark may consider that as a violation of his right and constitution conflicting between his trademark and registrant's domain name. In this case, the owner of the famous trademark may initiate a proceeding under the UDRP. According to Article 4 (a) of the UDRP, a trade mark's owner has the right to apply for one of the seven ICANN approved dispute resolution service providers by asking it to cancel or transfer of the registration of a domain name if three elements are met.

¹⁸ "gTLDs" is abbreviation to the "generic" TLDs. Each of the "gTLDs" bears a three or more letters (such as .com, net, and .org). They can be subdivided into two types, "restricted" or "sponsored" TLDs (sTLDs) and "not restricted or open" "unsponsored TLDs" (uTLDs). Each of the "generic" TLDs was created for a general category of organizations. In the 1980s, seven gTLDs (.com, .edu, .gov, .int, .mil, .net, and .org) were created. Domain names may be registered in three of these (.com, .net, and .org) without restriction; the other four have limited purposes. Internet Corporation for Assigned Names and Numbers (ICANN), Top-Level Domains (gTLDs), 2002, <http://archive.icann.org/en/tlds/> (Accessed 28 October 2015).

¹⁹ The UDRP is based on recommendations made by WIPO Internet in the report . On the first WIPO Internet Domain Name Process caused by the conflict between domain name and trademark. Also a number of further issues identified in that report that were considered to be outside the second WIPO Internet Domain Name Process. See, York, Stephen and Tunkel, Daniel, E-Commerce: a guide to the law of electronic business, second edition, Butterworths, London, 2000, p. 186.

²⁰ Internet Corporation for Assigned Names and Numbers (ICANN), List of Approved Dispute Resolution Service Providers, 2003, <https://www.icann.org/resources/pages/dndr-2012-02-25-en> (Accessed 15 October 2015).

²¹ SMITH 2002, p. 153.

These elements are:

1. the registered domain name is identical or confusingly similar to a trade or service mark in which the complainant has rights;
2. the registrant has no rights or legitimate interests in respect of domain name registered;
3. the domain name has been registered and is being used in bad faith.

In administrative proceedings, the claimant must “prove that each of these three elements are present” in order to succeed his case to cancel or transfer a registered domain name.²² In the followings we are going to discuss these elements in details.

4.1. Identical or Confusingly Similar

According to this element, the complainant must prove that domain name is identical or confusingly similar to his trade or service mark in order to succeed his case to cancel or transfer a registered domain name.²³ However, the complainant has to satisfy the panelist that he has the rights of trade or service mark in his mark. These rights can be as a result of registration of that mark as well as rights that come even without formal registration. Moreover, it is significant to understand here that the panelist, before issuing the decision, must give attention to a number of factors, including:

1. the distinctive character of the name and the requirement that the domain name must be “identical or confusingly similar” to it;
2. the relationship between this distinctive character and use of the name in connection with goods or services in commerce
3. the location of the parties and the bearing that this may have on the acquisition of unregistered trademark rights.²⁴

It is imperative to note that the location of the parties can be important for determining whether the complainant has trademark rights. Rule 15(a) of the Rules for UDRP (the “Rules of Procedure”) provides that the panel shall decide a complaint on the basis, *inter alia*, of “(...) any rules and principles of law that it deems applicable.” The applicable law will depend on the facts of the case, including the location of the parties. This rule has allowed panels the flexibility to deal with disputes between parties with different national concerning activity on a global medium. It is also a feature that has enabled complainants to seek protection for their names under trademark law, although they have not registered their names as a trademark or service mark in every country of the world.²⁵

²² Remedies available under the UDRP, article 3 are the transfer or cancellation, or otherwise making changes of the domain name. A UDRP panel decision to transfer or cancel a domain name will be implemented by the domain name registrar unless within ten business days, the domain name registrant files with the registrar official documentation evidencing the commencement of legal proceedings against the complainant in one of the jurisdiction to which the complainant has submitted under the UDRP rules of procedure.

²³ See rule 4 under Uniform Domain Name Dispute Resolution Policy (UDRP).

²⁴ The protection of personal names under the UDRP is discussed in the Report of the Second WIPO Internet Domain Name Process, dated September 3, 2001, under paragraphs 181–184. It is pointed out these relevant factors.

²⁵ World Intellectual Property Organization, THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM, report of the second WIPO Internet Domain Name Process.

Moreover, the complainants are in most cases easily able to prove this element. For example, in *Philip Morris Incorporated v. r9.net*,²⁶ the complainant claims that respondent has misappropriated complainant's famous Marlboro marks, and that the respondent's domain name "marlboro.com" is confusingly similar to the Marlboro marks because the disputed domain name completely incorporates the MARLBORO® mark. Furthermore, the complainant alleges that the respondent has no rights in the disputed domain. The evidence demonstrated that the complainant clearly has rights in a family of registered marks incorporating the MARLBORO® mark. In fact, the MARLBORO® mark was first registered 95 years ago in the United States, and apparently is among the most widely recognized trademarks in the USA. The panel found that the disputed domain name is identical or confusingly similar to complainant's registered marks. The complainant satisfied the panelist that he has the rights in his trademark. These rights can be as a result of registration of that mark. Moreover, the panelist, before issuing the decision "to cancel or transfer a registered domain name", gave attention to the requirement that the domain name must be "identical or confusingly similar" to trademark in which the complainant has rights by studying the distinctive character of the mark "MARLBORO" and the relationship between this distinctive character and use of the mark in connection with goods or services in commerce.²⁷

The theme was also expressed in *Shell International Petroleum Company Limited, Shell Trademark Management B.V. v. Domains - Best Domain*, the complainant in this case stated that the respondent's domain name is identical or confusingly similar to his trademark "SHELL". The evidence demonstrated that the respondent's domain name <wwwshell.com> is identical to complainant's trademark except for the addition of the letters "www" before the mark. Incorporating of complainants' famous trademark with the letters "www" is likely to appear to Internet users as though the domain name is identical to complainants' trademark, because most domain names include "www" followed by a dot before the second level domain name (SLD), and Internet users would most likely not notice the omission of the dot. Accordingly, the panel found that the domain name is confusingly similar to complainants' trademark "SHELL".²⁸

It is vital to recognize that the complainant, also in this case, satisfied the panelist that he has the rights in his trademark "SHELL". These rights can be as a result of registration of that mark. Moreover, the panelist gave attention to the requirement that the domain name must be "identical or confusingly similar" to trademark in which the complainant has rights by studying the distinctive character of the mark and the relationship between this distinctive character and use of the mark in connection with goods or services in commerce. Furthermore, in *John Swire & Sons Limited v. David Huang*, WIPO Case, the

World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions, 2015, <http://www.wipo.int/amc/en/processes/process2/report/html/report.html>. (Accessed: 10 September, 2015).

²⁶ WIPO Case No. D2003-0004. World Intellectual Property Organization (WIPO): Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2003-0004, 2015. <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0004.html> (Accessed 11 September 2015).

²⁷ Ibid.

²⁸ WIPO Case No. D2003-0066. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2003-0066, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0066.html> / (Accessed: 17 September 2015).

domain name with which this dispute is concerned is: "swiregroup.com". The complainant claims that respondent has registered the domain name which similar to complainant's trademarks "Swire", and that respondent has no rights in respect of the domain name. Consequently, The complainant requires the transfer of the domain name registration to the complainant. The panel therefore found the domain name is confusingly similar to trademarks in which complainant has rights.²⁹ It is vital to note here that also the complainant proved that domain name is confusingly similar to his trademark by satisfying the panelist that he has the rights in his trademark and these rights can be as a result of registration of that mark in many countries of the world.³⁰

4.2. Rights or Legitimate Interests

This element states that the complainant must prove that the registrant does not have rights or legitimate interests in respect of the domain name. Therefore, the complainant must make out a *prima facie* showing on Article 4 (a) (2) of the UDRP, that he has rights or legitimate interests, the burden shifts to the respondent to deny the showing by proving evidence that it has rights to or legitimate interests in the domain name.³¹ The concept of burden shifting is derived from Article 4(c) of the UDRP, entitled "How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint". Article 4(c) discusses the different kinds of evidence a respondent should provide to show that it has rights or legitimate interests in the domain name. Paragraph 4(c) of the UDRP sets out a number of circumstances, in order to demonstrate that the ownership of interests or rights. These circumstances are:³²

1. the registrant used or demonstrably prepared to use the domain name or a corresponding name in connection with a *bona fide* offering of goods or services prior to notice of the dispute;
2. the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark rights; or
3. the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the complainant's trade or service mark.

²⁹ The complainant is John Swire & Sons Limited of Swire House, 59 Buckingham Gate, London SW1E 6AJ, England. Complainant is represented by: Johnson Stokes & Master, 10th Floor, Prince's Building, 10 Charter Road, Central Hong Kong. The respondent is: David Huang, of 4F, 256 Nanking East Road, Sec.5, Taipei City, Taiwan 105. The Respondent is not represented. WIPO Case No. D2000-1106. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2000-1106, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1106.html/> (Accessed 18 September 2015).

³⁰ Ibid

³¹ See paragraph 4 (c) of the Uniform Domain Name Dispute Resolution Policy (UDRP). Internet Corporation for Assigned Names and Numbers (ICANN), Uniform Domain-Name Dispute-Resolution Policy, 1999, <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (Accessed 9 October 2015).

³² Paragraph 4 (c) of the Uniform Domain Name Dispute Resolution Policy (UDRP). Internet Corporation for Assigned Names and Numbers (ICANN), Uniform Domain-Name Dispute-Resolution Policy, 1999, <https://www.icann.org/resources/pages/policy-2012-02-25-en#4aii> (Accessed 10 October 2015).

In *John Swire & Sons Limited v. David Huang*³³ the WIPO panel shifted the burden of proof to the respondent due to the fame of the complainant. The panel stated that the renown of complainant's group of companies and the wide-spread trade mark registrations which it holds renders it almost impossible for respondent to claim any such right or interest. Whilst the burden of proof lies on complainant, that burden is a shifting one and respondent has done nothing to deny complainant's *prima facie* showing. It should be noticed that the respondent failed to file a response or to otherwise assert any such right or interest. The respondent has done nothing to deny complainant's *prima facie* by showing evidence that it has rights or legitimate interests in the domain name, such as, that he used or prepared to use the domain name or a corresponding name in connection with a *bona fide* offering of goods or services prior to notice of the dispute.

Moreover, in *INTOCAST AG v. Lee Daeyoon*, it was very hard for the complainant to actually prove that respondent does not have rights or legitimate interests in respect of the domain name. The burden thus shifted to the respondent to deny the evidence of complainant by proving evidence that it has rights to or legitimate interests in the domain name.³⁴

It should be noted that the respondent of this case presented to the panel the evidence that it has rights to or legitimate interests in the domain name by using the domain name in connection with a *bona fide* offering of goods or services prior to notice of the dispute. Consequently, the panel is convinced that the domain name has been registered and is being used in *bonafide* by the respondent.

Also, in *Shell International Petroleum Company Limited, Shell Trademark Management B.V. v. Domains - Best Domain* the respondent has not provided any evidence of rights or legitimate interest in the domain name as well as has not presented evidence that

- it used or made preparations to use the domain name in connection with a *bona fide* offering of goods or services, or,
- it is commonly known by the domain name, or,
- it is making a noncommercial or fair use of the domain name.

³³ WIPO Case No. D2000-1106. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2000-1106, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1106.html> (Accessed 20 September 2015).

³⁴ WIPO Case No. D2000-1467. Complainant is INTOCAST AG, Kaiserswerther 86-88, 40880 Ratingen, Germany. Respondent is Lee Daeyoon, Hangyureh 3rd floor, 116-25 Gongduk, Mapo, Seoul, 121-020, Republik of Korea. Complainant contends that respondent has registered the domain name which is identical to complainant's "INTOCAST" mark, that respondent has no rights or legitimate interests in respect of the domain name, and that the domain name has been registered and is being used in bad faith. Consequently, complainant requires the transfer of the domain name registration to the Complainant. Respondent has not contested the allegations of the complaint and is in default. Since the panel found that not all of the elements under paragraph 4(a) are fulfilled, the complaint is dismissed. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2000-1467, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1467.html>. (Accessed 20 September 2015).

In this case, the panel found that respondent does not have any right or legitimate interest in the domain name.³⁵

4.3. Bad Faith Registration and Use

Bad faith registration and use is the last element required by the UDRP in order to cancel or transfer a registered domain name. This element states that the complainant must prove that the domain name has been registered and is being used in bad faith.

The establishment of a proof for bad faith is the core matter with regard to the policy, as it originally aims at protecting the rights of a legitimate owner of a trademark against those who registered and used it in bad faith. The UDRP demonstrates these factors that the availability of which will indicate bad faith:

1. circumstances indicating registration of domain name primarily for the purpose of selling, renting, or otherwise transferring that registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name;
2. domain name registration to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name;
3. domain name registration primarily for the purpose of disrupting the business of a competitor;
4. domain name registration to intentionally attempt to attract, for commercial gain, Internet users to its web-site (or other on-line location) by creating a likelihood of confusion with the complainant's trade or service mark as to the source, sponsorship, affiliation, or endorsement of the web-site or a product or service on the web-site.³⁶

In most, if not all cases where there is a finding of bad faith registration and use, the other elements are also met, and the decision is in favor of the complainant. The complainant must show that both the registration and the use are in bad faith. For example, in *Philip Morris Incorporated v. r9.net* the respondent had legal, if not actual, notice of complainant's marks prior to registering the disputed domain name. Certainly, the MARLBORO® mark has been registered for 95 years, and is one of the most famous trademarks in the USA; it is inconceivable that respondent was not aware of the MARLBORO® mark when it registered the disputed domain name. The panel therefore found that the disputed domain name was registered in bad faith. Moreover, it appears that this respondent has engaged in a pattern of bad faith conduct by registering many domain names containing well-known marks, and using them to direct traffic to other sites for commercial gain.³⁷ In addition to "marlboro.com", respondent has registered 100 other domain names. It has been found that all these other registered domain names, that

³⁵ WIPO Case No. D2003-0066. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2003-0066, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0066.html> (Accessed 20 September 2015).

³⁶ Under Article 4(b) of the UDRP these circumstances are non-exclusive, but serve only for examples.

³⁷ *Ibid*

included famous trademarks owned by third parties. All these facts led the panel to the result that the respondent has registered and used the domain name in bad faith.³⁸ According to this case the complainant did not demonstrate any of the factors listed in Article 4(b) of the UDRP which may indicate to bad faith use.

Further, in *Shell International Petroleum Company Limited, Shell Trademark Management B.V. v. Domains - Best Domain*, WIPO Case, the complainant has presented evidence that respondent offered to sell the domain name for \$549.00, which indicates that respondent acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainants. Also, in this case, the panel found that respondent has registered and used the domain name in bad faith.³⁹ Article 4(b)(1) of the UDRP is directly applicable in this situation. This article includes use of the domain name intentionally to sell, rent, or transfer that registration to the complainant who is the owner of the trademark. It should be noted that the complainant presented evidence that respondent offered to sell the domain name for \$549.00 to the complainant or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.⁴⁰

The theme was also expressed as follows in, *Ingram Micro, Inc. v. Ingredients Among Modern Microwaves*, WIPO Case, under this case, there is no evidence of bad faith use and no effort has been made to sell the domain names to the mark owner or a competitor and no attempt to attract users to the site for commercial gain. In this case, the panel found the complainant has failed to establish bad faith use.⁴¹ In this case, it is vital to note that there is not any factors which may indicate to bad faith use according to Article 4(b) of the UDRP which states that these circumstances or factors are non-exclusive but for example. However, it should be mentioned here that instead of some non-exclusive circumstances which are clarified by Article 4(b) of the UDRP there is a great need for international community to agree in formal way to offer resolution of the conflict between domain names and trademarks policy by including more clear standard to decide whether certain registration or use of domain name is made in bad faith or not.⁴²

Conclusion

This study resulted in finding that the main method by which the conflict between domain names and trademark can be settled internationally through the Uniform Dispute Resolution Policy adopted (UDRP) by the Internet Corporation for Assigned Names and

³⁸ WIPO Case No. D2003-0004. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2003-0004, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0004.html> (Accessed 20 September 2015).

³⁹ WIPO Case No. D2003-0066. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2003-0066, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0066.html> (Accessed 25 September 2015).

⁴⁰ Ibid.

⁴¹ WIPO Case No. D2002-0301. World Intellectual Property Organization (WIPO), Search WIPO Cases and WIPO Panel Decisions/ WIPO Case No. D2002-0301, 2015, <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0301.html> (Accessed 25 September 2015).

⁴² Ibid.

Numbers (ICANN). The UDRP states that any person or entity with rights in a trademark may initiate an administrative dispute resolution proceeding by submitting a complaint to one of the seven ICANN approved dispute resolution service providers:

1. Asian Domain Name Dispute Resolution Center (ADNDRC).
2. The world intellectual property organization (WIPO).
3. The national Arbitration forum (NAF).
4. E-Resolution.
5. The CPR institute for dispute resolution, as mentioned above.
6. Arab Center for Domain Name Dispute Resolution (ACDR).
7. The Czech Arbitration Court Arbitration Center for Internet Disputes.⁴³

According to the UDRP: the trademark owner must prove that the domain name registered is identical or confusingly similar to a trade or service mark in which the trademark owner has rights, the registrant has no rights or legitimate interests in respect of domain name registered, and the domain name has been registered and is being used in bad faith.

Finally, it should be mentioned here that UDRP panels can only decide to transfer or cancel the domain name or deny the complaint, however, UDRP is not the proper way for claiming damages or monetary remedies, simply because the powers granted to a panel applying the policy are merely reflecting the contractual provision embodied in the phase of registering the domain name. In other words, the UDRP panels can only decide to transfer or cancel the domain name or deny the complaint. It is not possible for the panel to make any monetary judgments. From my point of view, I see that there is also a great need for international community to agree in a formal way to offer new rules under UDRP to justify claims for damages and lost profit in front of the panel, beside of the panel power to transfer or cancel the domain name, or deny the complaint. However, I think that issuing such new rules will not be an easy task; it will take a long period of time, and need to spread awareness of the importance and value of domain names in order to offer new rules under UDRP to give the power for the panel to make any monetary judgments.

WADDAH AL RAWASHDEH

A DOMAIN NEVEKKEL KAPCSOLATOS VITARENDEZÉS AZ EGYSÉGES VITARENDEZÉSI POLITIKA ALAPJÁN

(Összefoglaló)

Az alábbi írás a domain nevek és a védjegyek között felmerülő vitás helyzeteket vizsgálja a domain nevek kettős rendeltetésének – így Internet címként és megkülönböztető képességű védjegyként betöltött funkciójának – a tisztázása révén.

⁴³ Internet Corporation for Assigned Names and Numbers (ICANN): List of Approved Dispute Resolution Service Providers, 2003. <https://www.icann.org/resources/pages/dndr-2012-02-25-en> (Accessed 15 October 2015).

A tanulmány a védjegyek és a domain nevek közötti ütközéseket vizsgálja a köztük fennálló összefüggések, valamint az ezek között felmerülő konfliktushelyzetek bemutatása révén, így például azokat az eseteket, amikor egy domain név azonos vagy megtévesztő hasonlóságot mutat egy védjegyjogosult áru- vagy szolgáltatási védjegyével (vö.: cyberquatting és typo-squatting). A tanulmány a domain nevek és a védjegyek közötti jogviták legfontosabb nemzetközi vitarendezési módszerére fókuszált, amely az Internet Corporation for Assigned Names and Numbers (ICANN) által felügyelt Egységes Vitarendezési Politika (UDRP). Az UDRP alapján a védjegy jogosultjának kell bizonyítania, hogy a más által regisztrált domain név a védjegyjogosult által törvényesen bejegyzett áru- vagy szolgáltatási védjeggel azonos, vagy ahhoz megtévesztő módon hasonlít, az azonos domain név regisztrálójának nincs joga vagy törvényes érdeke a domain név használatára, és hogy a domain név rosszhiszeműen került nyilvántartásba vételre, illetve használata is rosszhiszemű.

A tanulmány rávilágít arra, hogy az UDRP vitarendezési panelek kizárólag a domain nevek átengedéséről, törléséről, valamint a jogosult által benyújtott panasz elutasításáról dönthetnek, ugyanakkor kártérítést nem szabhatnak ki a jogsértőkkel szemben.